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OFFICE OF PETITIONS

In re Application of
Raymond J. Gorte et al
Application No. 10/053,085
Filed: November 9, 2001
Attorney Docket No. PENN.N2437 C

ON PETITION

This is a decision on the petition under 37 CFR 1.78(a)(6), filed August 19, 2002, to accept an unintentionally delayed claim under 35 U.S.C.§ 119(e) for the benefit of prior filed provisional Application No. 60/289,462, filed May 8, 2001.

The petition is DISMISSED AS MOOT.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000.

The instant pending nonprovisional application was filed on November 9, 2001, within twelve months of the filing date of prior filed provisional application Application No. 60/289,462, which was filed on May 8, 2001, and for which priority is claimed. The claim for priority filed August 19, 2002, to provisional Application No. 60/289,462, was filed within sixteen months from the filing date of the provisional application. Therefore, no petition is necessary.

A reference to add the above-noted, prior-filed application on page one following the first sentence of the specification has been included in an amendment filed on August 19, 2002. However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

> Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both appli-cations, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

Accordingly, if petitioner desires to have the amendment considered a substitute amendment deleting the incorporation by reference statement must be submitted.

The application is being forwarded to Office of Initial Patent Examination for further processing.

Any questions concerning this matter may be directed to Karen Creasy at (703) 305-8859 .

Frances Hicks
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for Patent Examination Policy